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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/878,908	06/19/1997	KARL-LUTZ LAUTERJUNG	09114/005001	8837

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EXAMINER	
PREBILIC, PAUL B	
ART UNIT	**PAPER NUMBER**
3738	37

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	08/878,908	LAUTERJUNG, KARL-LUTZ	
	Examiner	Art Unit	
	Paul B. Prebilic	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 February 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-25,28,32,33,36 and 63-66* is/are pending in the application.

4a) Of the above claim(s) *21-25 and 28* is/are withdrawn from consideration.

5)☒ Claim(s) *32,33 and 36* is/are allowed.

6)☒ Claim(s) *63-66* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 7, 2004 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 63-66 are rejected under 35 U.S.C. 102(e) as being anticipated by Carpenter et al (US 5,643,314). Carpenter anticipates the claim language where the graft as claimed is the thin layer of material covering the cylinder (16) (see column 9, lines 52-59 and Figure 2), the ring of windings as claimed is any one of the radial bands of cylinder (16) which overlap radially in at least one part thereof, and the ring is resilient as claimed because it is self-expanding; see column 5, line 65 to column 6, line 18. The

thin layer of Carpenter must be a graft because it is implantable, and it must be tubular and have free ends because it covers a cylinder that has free ends.

With regard to claims 64 and 65, the minimum bending diameter would inherently be smaller as claimed if the overlapping areas were solid because the overlapping structure is the same structure as that claimed and disclosed by Applicant; see Figure 2 of the present application.

Claim 65 is rejected under 35 U.S.C. 102(b) as being anticipated by Elliot et al (US 4,041,931). Elliot anticipates the claim language where the tubular graft as claimed is the vein (30) of Elliot, which has a free end joined to the aorta and a second unjoined free end (see Figure 4). The ring comprising overlapping windings of wire as claimed is met by split ring (12) with eyelet (22) respectively; see column 2, line 36 et seq. The windings of Elliot are considered to be overlapping concentrically, to the extent claimed, because they are of the same diameter and aligned with each other. Since any physical ring has a finite width, the center thereof cannot be said to be a single dimensionless point. In addition, the ring is coaxial with the tubular graft even though the windings are not such that the claim language is fully met in this regard. The minimum bending diameter would inherently be smaller as claimed if the eyelet (22) were stressed as shown in Applicant's Figure 2 because the eyelet (22) is the same structure as that claimed.

Claim 65 is rejected under 35 U.S.C. 102(b) as being anticipated by Lazarus (US 5,275,622). Lazarus anticipates the claim language where the tubular graft as claimed is the graft (121) of Lazarus (see Figures 10 and 11), the ring as claimed is spring

means (131) of Lazarus, and the bundle of overlapping wires as claimed are any of the helical coil springs (136) of Lazarus; see column 8, lines 25-66. The windings are interpreted in the same manner as with the earlier Elliot rejection in that they are not required to be concentric with the graft. The minimum bending diameter as claimed is inherently present if the coil spring (136) is stressed as in Figure 2 of Applicant's disclosure because it is the same structure as claimed.

Allowable Subject Matter

Claims 32, 33 and 36 are allowed over the prior art of record.

Response to Arguments

Applicant's arguments filed January 7, 2004 have been fully considered but they are not persuasive or are moot in view of the new ground of rejection.

Applicant argues that the minimum bending diameter limitation is not met because it is not necessarily present in the applied prior art; see paper number 32 on page 6. However, the Examiner asserts that since the same material (i.e. metal) in the same configuration (overlapping windings of wire) as claimed is present in each of the prior art devices that the minimum bending diameter limitation is inherently met. It is not required that the prior art explicitly recite a minimum bending diameter. Rather, the prior art must reasonably contain the claimed property; see MPEP 2112, which is incorporated here by reference. Since the same structures as claimed are present in the applied art, these structures must have the same properties as claimed.

Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure

outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 of 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Kelman (US 5,123,906) is cited because it discloses that nylon fiber has been called nylon wire in the art; see column 2, lines 31-40. However, Applicants have limited themselves to the definition given by the Board of Appeals as "metal in the form of a flexible thread or slender rod"; see the footnote on page 6 of the Decision rendered September 13, 2002.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for this Technology Center is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.

Paul Prebilic
Primary Examiner
Art Unit 3738